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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,652	01/27/2004	Younger Ahluwalia	03137.000004	3967

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EXAMINER

RUDDOCK, ULA CORINNA

ART UNIT PAPER NUMBER

1771

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,652

Applicant(s)

AHLUWALIA ET AL.

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/15/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner has carefully considered Applicant's response filed August 1, 2005. The double patenting rejections over US 6,872,440, US 6,858,550, US 6,586,353, Application No. 10/354216, Application No. 10/354220, Application No. 10/354219, and Application No. 10/766654 have been overcome. The rejections in view of Horner, Jr. et al. (US 6,365,533) and Ahluwalia (US 5,965,257) have been overcome. However, after an updated search, additional prior art has been found which renders the invention as currently claimed unpatentable for reasons herein below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/766649. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection is maintained.

4. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/766678. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection is maintained.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horner, Jr. et al. (US 6,365,533) in view of Ahluwalia (US 5,965,257) and Dimakis (US 5,345,738). Horner, Jr. et al. disclose a pliable facer comprising a preformed glass mat, a binder, and a coating comprising fillers, surfactant, and flame retarding additives (abstract). Because a surfactant is present in Horner's composition, surfactant-generated microcells would also be present in the material. Fillers useful in the coating composition comprise clay and antimony oxide (col 3, ln 44-49). The coating

composition further comprises surfactants including fatty acids (col 3, ln 50-57), which are disclosed by Applicant in the specification. The latex component of the coating composition includes latex polymers including copolymers of styrene and butadiene and acrylic based resins (col 3, ln 58-61), which are preferred binders disclosed in the present specification. The coating composition also comprises a coloring agent (i.e. dye) (col 5, ln 28). Horner et al. disclose the claimed invention except for the teaching of a metallic component adhered to the coated substrate. Horner et al. also fail to disclose that the substrate has an ionic charge and a coating which coats the substrate having essentially the same ionic charge and that the composite material further requires water repellant material, antifungal material, antibacterial material, a surface friction agent, and an algaecide. Horner, Jr. also fail to disclose that the material comprises 5-10% glass fibers, 80-90% coating, and from 5-10% metallic component.

Ahluwalia disclose a structural article used as facing sheets (col 3, ln 36-37) comprising a substrate having an ionic charge which is coated with a coating having essentially the same ionic charge. The coating consists of a filler material and a binder material. The substrate is preferably fiberglass and the filler is selected from flay ash, charged calcium carbonate, and ceramic microspheres. The binder is preferably acrylic latex (abstract). The articles are planar in shape and the substrate is coated on one side or both sides depending on the intended application (col 3, ln 42-44). The structural material may be coated with a water repellent material, an algaecide, an antifungal material, an antibacterial material, a surface friction agent, a flame retardant material, and a coloring dye (col 3, ln 54-67 to col 4, ln 1-3).

Dimakis discloses a multi-functional exterior structural foam sheathing panel (abstract). The panel comprises fibrous sheets, vapor-impervious sheets, and an insulating core (col 3, ln 19-21). The core is composed of a polyisocyanurate foam (col 3, ln 35-36). Metallic foil can be adhered between the core and fibrous sheet on both sides of the core (col 5, ln 57-61) via a polymeric adhesive (col 3, ln 30-32). The foil can be aluminum (col 5, ln 65).

It would have been obvious to have used Dimakis' metallic aluminum sheet on the foamed mat of Horner and Ahluwalia, motivated by the desire to create a composite material that is vapor impervious.

It would have been obvious to have used Ahluwalia's teaching of a substrate having an ionic charge which coated with a coating having essentially the same ionic charge on the facer material of Horner, Jr. and Dimakis, motivated by the desire to create a material that has zero bleed through and that eliminates costly and time consuming processing steps such as blowing. It also would have been obvious to one having ordinary skill in the art to have used Ahluwalia's water repellent material, antifungal material, antibacterial material, surface friction agent and algaecide on the glass mat of Horner, Jr. et al., motivated by the desire to create a fibrous product having resistance to water, fungus, algae, bacteria, and to improve the surface friction of the product and to make the composition more durable.

Furthermore, it should be noted that optimizing the amounts of glass fibers, coating, and metallic component in the composition are result effective variables. For example, the amount of glass fibers and coating directly affects the flame resistance of the composition. The amount of metallic component directly affects the strength of the composition. Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to have used a material comprising 5-10% glass fibers, 80-90% coating, and from 5-10% metallic component, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized these amounts motivated by the desire to obtain an article with increased strength, durability, and flame resistance.

Response to Arguments

7. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR *UCR*

Ula Ruddock
Ula C. Ruddock
Primary Examiner
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